UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/452,811	12/02/1999	MASAYUKI CHATANI	991202	1782

25920	7590	06/14/2005

MARTINE PENILLA & GENCARELLA, LLP
710 LAKEWAY DRIVE
SUITE 200
SUNNYVALE, CA 94085

EXAMINER
DINH, DUNG C

ART UNIT	PAPER NUMBER
2152	

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/452,811	CHATANI, MASAYUKI
	Examiner	Art Unit	
	Dung Dinh	2152	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _28 February 2005_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-10,12-30 and 32-41_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-10,12-30,32-41_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 2/28/05 have been fully
considered but they are not persuasive.

Regarding the argument concerning claims that the auxiliary
content being advertisements, the argument is moot in view of
new ground of rejection below.

Regarding the argument concerning claims 27, 28, 29 and 40,
that Hoffberg does not teach creating a record of playback and
uploading the record to the server. The argument is not
persuasive. Although Hoffberg discloses tracking the "receipt"
of advertisement (col.63 lines 12-19), however, he further
discloses tracking the number of impressions made to the same
viewer (col.63 lines 20-23). Hence, it is apparent that the
playback of the advertisement must be recorded in order to track
how many times the viewer saw the advertisement. Since the data
are kept at an accounting server, the viewing record data
clearly must be transmitted to the accounting server.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10, 12-26, and 29-30, 32-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collart US patent 6,453,420 and further in view of Hoffberg et al. US patent 6,400,996.

As per claim 1, Collart teaches a system for providing access to primary media content in digital form, comprising:

a server network [fig.2] comprising a download management server, database storing user information and primary media content [fig.2 #232, #234, #236];

a client console connectable through a bi-directional communication network to download management server [fig.2], the console generating a user identifier (by reading the BCA information);

a detachable storage media [220] installable in the client console, the detachable storage media having data structure thereon comprising auxiliary media content and associated

trigger data items [inherent from col.22 lines 41-60. Collart's

disc contains various media elements. The disc inherently has

information logically associated with the media elements (e.g.

an index, allocation table, etc.) in order for the playback

system to identify what and where each media elements are on the

disc to playback], and user identifier [BCA data];

wherein the user identifier is upload to the server to

enable access to specified content and user information is

downloaded to the client console to trigger execution of

specific auxiliary media content items. [See col.15 lines 10-35,

col.19 lines 1-9, col.22 line 40 to col.23 line 34]. The

identifying data send back from the server specifies the media

elements to be played. Hence, the client device inherently does

a comparison to 'trigger' data on the media to retrieve the

correct media elements for playback].

Collart does not teach the auxiliary media on the

detachable storage being comprises of advertisements. In

similar field of invention for delivering content, Hoffberg

teaches providing auxiliary content comprises of advertisements

on detachable storage (CD-ROM or DVD), the viewing of which may

be used as credit for viewing of primary content (see col.62

lines 49-63, col.63 lines 41-44). Hence, it would have been

obvious for one of ordinary skill in the art to combine the

teaching of Hoffberg with Collart because it would have placed

the advertisements readily available at the viewer and enabled

the viewer the option to reduce his cost of access to desired

content by choosing to view the advertisements.

As per claims 2 and 4, Collart teaches the user identifier

comprises media ID identifying the storage media and

authentication code [col.15 lines 10-35, col.19 lines 1-9].

As per claims 3 and 5, Collart teaches using the user

identifier to limit access to specified primary content [col.15

lines 30-35, col.23 lines 36-40].

As per claims 6-7, Collart teaches providing a program for

providing network access and code to causes execution of program

stored on the client console for providing network access

[col.14 lines 25-59].

As per claim 8, Collart teaches the client has local fixed

storage device [apparent from col. 26 lines 1-25 in order to

store the update and application information].

As per claim 9, Collart teaches a method comprising the

steps of:

establishing communication to download management server

[col.14 lines 10-13];

transmitting user identifier contained on the local storage

media and a request for primary media content to the server

[col.14 lines 51-59];

downloading from the server to the client console primary

media content and user information [col.20 line 60 to col. 21

lines 6];

accessing auxiliary content on the detachable storage on

the basis of the returned user information and overriding

playback for enabling viewing of the primary media [col.23 lines

55 to col.24 9];

storing a record of the viewing and uploading to the server

[col.24 lines 7-9].

Collart does not teach the auxiliary media on the

detachable storage being comprises of advertisements and

selectively overriding playback of the auxiliary content. In

similar field of invention for delivering content, Hoffberg

teaches providing auxiliary content comprises of advertisements

on detachable storage (CD-ROM or DVD), the viewing of which may

be used as credit for viewing of primary content (see col.62

lines 49-63, col.63 lines 41-44). Hoffberg teaches enabling the

viewer to selectively playback the auxiliary content [col.64

lies 35-42] to earn subsidy for viewing of primary content or to

pay for commercial free content [col.60 lines 10-15, col.62

lines 49-63]. Hence, it would have been obvious for one of ordinary skill in the art to combine the teaching of Hoffberg with Collart because it would have placed the advertisements readily available at the viewer and enabled the viewer the option to reduce his cost of access to desired content by choosing to view the advertisements.

As per claim 10, Collart teaches having media identifier and authentication code [col.19 lines 1-3]. Collart teaches using the identifier and code to restrict access to primary content [col.23 lines 35-40].

As per claim 12, Hoffberg teaches storing primary content on local storage [col.59 lines 10-15].

As per claim 13, it is rejected under similar rationale as for claim 9 above. Collart teaches determining whether connection to the network is required for the operation of the client console [apparent from col.14 lines 5-39: case 2 & 3].

As per claims 14-15, Hoffberg discloses monitoring the user "veto" viewing of auxiliary content [col.64 lines 40-43]. It is apparent that the system as modified would have the step of polling to determine if the user overrides the playback of auxiliary content and to update viewing record accordingly. It would have been obvious for one of ordinary skill in the art to

do so because it would have enabled the system to keep accurate record of the user's viewing.

As per claims 16-18, the timing of the upload of the viewing record would clearly have been a matter of design choice. It would have been obvious for one of ordinary skill in the art to upload the viewing record at various times as the situation required.

As per claim 19, Collart teaches prompting the user for user information and to associate with the user with the media identifier [col.20 lines 59-60].

As per claims 20 and 22, they are rejected under similar rationale as for claim 1 above. Inherently the disc contains plural triggers (e.g. content index, storage location on the disc, etc.). Furthermore, Hoffberg teaches matching the advertisements to the primary content and profile of the viewer (col.64 lines 8-12). Hence, it would have been obvious for one of ordinary skill in the art to include various 'trigger data' such as descriptive headers or other classification data so as to enable the system to quickly select matching contents.

As per claims 21 and 23, Collart teaches providing a program for providing network access and code to causes execution of program stored on the client console for providing network access [col.14 lines 25-59].

As per claim 24, Hoffberg teaches enabling the viewer to selectively playback the auxiliary content [col.64 lies 35-42].

As per claim 25, Collart and Huffberg suggest storing a record of the viewing and uploading to the server [Collart col.24 lines 7-9; Hoffberg col.63 lines 12-24].

As per claim 26, Collart does not specifically disclose the console being a personal digital assistant (PDA). The type of device for playing the media would clearly have been a matter of design choice. It would have been obvious for one of ordinary skill in the art to use a PDA because it would have enabled the user to be mobile and to have computing functionality while using the media.

As per claims 29+32, 33, they are rejected under similar rationale as for claim 9 above. Hoffberg teaches assessing fee to auxiliary content provider (advertiser) based on playback records accumulated by the server [see col.60 lines 10-24].

As per claim 30, Collart teaches having media identifier and authentication code [col.19 lines 1-3]. Collart teaches using the identifier and code to restrict access to primary content [col.23 lines 35-40].

As per claims 34-35, Hoffberg discloses monitoring the user "veto" viewing of auxiliary content [col.64 lines 40-43]. It is apparent that the system as modified would have the step of

polling to determine if the user overrides the playback of
auxiliary content and to update viewing record accordingly. It
would have been obvious for one of ordinary skill in the art to
do so because it would have enabled the system to keep accurate
record of the user's viewing.

As per claims 35-38, the timing of the upload of the
viewing record would clearly have been a matter of design
choice. It would have been obvious for one of ordinary skill in
the art to upload the viewing record at various times as the
situation required.

As per claim 39, Collart teaches prompting the user for
user information and to associate with the user with the media
identifier [col.20 lines 59-60].

**Claims 27-28 and 40-41 are rejected under 35 U.S.C. 103(a)
as being unpatentable over Hoffberg et al. US patent 6,400,996.**

As per claim 27, Hoffberg teaches a system for assessing a
fee for auxiliary content [col.60 10-15], wherein the auxiliary
content comprises advertisements [col. 63 lines 29-24],
comprising:

a server [service provider];

auxiliary content provider [advertiser]; and

a client node [user] connectable with the server through a
communication network for executing playback of auxiliary content
stored on a detachable storage media [col.63 lines 41-42],

wherein a fee to the auxiliary content provider is assessed
based on the playback record [col.60 lines 10-15].

Hoffberg does not specifically state creating record
indicating playback of the auxiliary content, and uploading the
record to the server. However, Hoffberg suggests collecting data
to at a central system to enable verification and to reduce fraud
and to track the number of times an advertisement is viewed by a
user [see col.63 lines 12-24]. Hence, it would have been obvious
for one of ordinary skill in the art to create record of the
playback at the client node because it would have enable the
system to efficiently track and verify actual playback of the
auxiliary content.

As per claim 28, it is rejected under similar rationale as
for claim 27 above.

As per claim 40, Hoffberg teaches a server network [service
provider] for assessing a fee for auxiliary content [commercials]
of auxiliary content provider [advertiser], comprising: a download
manager server [col.63 line 25 subscription television system], a
customer database and content database [inherent in order to keep
track of subscriber and providing content],

wherein the sever receives record indicating playback of the
auxiliary content item and accumulate the playback record to
assess a fee to the auxiliary content provider. [Apparent from
col. 60 lines 10-17, col.62 lines 50-68, col. 63 lines 12-24,
col.64 lines 39-43; since Hoffberg teaches accounting to collect
data to verify receipt of the advertisement]. Hoffberg does not
specifically disclosing receiving the record from the client
device. However, given the teaching of Hoffberg on col.63 12-24,
it would have been obvious for one of ordinary skill in the art to
keep record playback at the client device and transmit to the
server because it would have enabled efficient and accurate
tracking of receipt and playback of the contents.

As per claim 41, Hoffberg teaches the playback record is used
to update the customer database [col.64 lines 30-43].

Conclusion

Applicant's amendment necessitated the new ground(s) of
rejection presented in this Office action. Accordingly, **THIS
ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is
reminded of the extension of time policy as set forth in 37
CFR 1.136(a).

A shortened statutory period for reply to this final action
is set to expire THREE MONTHS from the mailing date of this

action.   In the event a first reply is filed within TWO MONTHS

of the mailing date of this final action and the advisory action

is not mailed until after the end of the THREE-MONTH shortened

statutory period, then the shortened statutory period will

expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated

from the mailing date of the advisory action.   In no event,

however, will the statutory period for reply expire later than

SIX MONTHS from the mailing date of this final action.

        Any inquiry concerning this communication or earlier
communications from the examiner should be directed to Dung Dinh
whose telephone number is (571) 272-3943. The examiner can
normally be reached on Monday-Friday from 7:00 AM - 3:00 PM.
        If attempts to reach the examiner by telephone are
unsuccessful, the examiner's supervisor, Glenton Burgess can be
reached at (571) 272-3949.
        The fax phone number for the organization where this
application or proceeding is assigned is 703-872-9306.
        Information regarding the status of an application may be
obtained from the Patent Application Information Retrieval
(PAIR) system. Status information for published applications
may be obtained from either Private PAIR or Public PAIR. Status
information for unpublished applications is available through
Private PAIR only. For more information about the PAIR system,
see http://pair-direct.uspto.gov. Should you have questions on
access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

Dung Dinh
Primary Examiner
June 3, 2005